

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:	Cox et al.	DOCKET NO:	P2702US
SERIAL NO.:	10/775,746	ART UNIT:	3677
FILED:	February 10, 2004	EXAMINER:	William L. Miller
CONF. NO.:	1553		
TITLE:	METHOD FOR CUSTOMIZING A BURIAL VAULT CARACE		

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Mail Stop AF
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicant respectfully requests a pre-appeal brief conference pursuant to the U.S.P.T.O. Official Gazette Notice “New Pre-Appeal Brief Conference Pilot Program” dated 12 July 2005, as extended by the U.S.P.T.O. Official Gazette Notice “Extension of the Pilot Pre-Appeal Brief Conference Program” dated 07 February 2006. As required by this procedure, Applicant is herewith providing, in five or less total pages, a succinct, concise and focused set of arguments for which the review is being requested.

The Applicant submits that the present request is proper because, in the view of the Applicant, the final rejection is founded upon clear legal and factual deficiencies rather than presenting an issue based upon a subjective interpretation of the claims or prior art teachings. The Applicant asserts that clear error exists in the Examiner’s final rejection of independent claims 1, 16, and 17 under 35 U.S.C. § 103(a) as obvious over U.S. Patent Publication No. 2003/0167706 (“Pazar”) in view of U.S. Patent No. 4,219,596 (“Takemoto”).

The invention generally relates to a decorative carapace for a burial vault. The burial vault has a decorative graphic attached to a top surface of a carapace that is made of a plastic-based material that is attached with an adhesive.

Examiner's Position

In the Final Office Action, the Examiner asserted that the combination of Pazar and Takemoto rendered the independent claims (and others) obvious.

In reading the Pazar reference onto claim 1, the Examiner stated, on p. 2, that:

Pazar discloses a decorative carapace for a burial vault comprising: a carapace 2910 (Fig. 28) having a top surface; and a metal substrate (nameplate) 2310 having a decorative graphic (name and date) and being attached/adhered to the top surface via screws.

The Examiner stated that Pazar fails to disclose the substrate as being a transparent substrate having a decorative graphic printed therein wherein the substrate is attached to the carapace via a transparent adhesive. The Examiner then provided the Takemoto reference as disclosing:

...a decorative assembly comprising a transparent substrate 16 having a decorative graphic 18 printed therein wherein the substrate is attached to a structure via a transparent adhesive (col. 3, lines 59-60) such that the graphic appears to be part of the structure as opposed to appearing "stuck on" (col. 3, lines 57-62).

As for motivation to combine, the Examiner stated, on p. 2-3:

[I]t would have been obvious...to modify Pazar by replacing the metal substrate with a transparent substrate having a decorative graphic printed therein wherein the substrate was attached to the carapace via a transparent adhesive.

The Examiner then relied upon KSR's rationale relating to a simple substitution of one known element for another to obtain predictable results, noting:

The substitution of the metal substrate with a transparent substrate having a decorative graphic printed therein wherein the substrate was attached to the carapace via a transparent adhesive would improve the appearance of the vault as the graphic would appear to be part of the structure.

The Examiner, on p. 5, characterized the substitution as the mere replacing of one known display substrate (Pazar's metal substrate with graphics) with another known display substrate (Takemoto's transparent substrate with graphics).

The Examiner indicated, on p. 6, that the revised affidavit of Marty Cox was insufficient to overcome the 35 U.S.C. § 103 rejection because:

The provided gross sales figures and evidence as to market share is insufficient to effectively establish commercial success as there is no means (data) to evaluate the increase in market share versus the industry, such as expected sales data.

Applicant's Position

The Examiner incorrectly states the showing requirements for the affidavit filed under 37 C.F.R. § 1.132. MPEP § 716.03(b)(IV) states:

IV. < SALES FIGURES MUST BE ADEQUATELY DEFINED

Gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988).

Thus, although this section clearly indicates that mere gross sales figures are inadequate to show commercial success, there are two evidentiary alternative mechanisms for remedying this: a) providing evidence of market share; or b) providing evidence as to what sales would normally be expected in the market.

In fact, *Ex parte Standish* actually contains a more accurate statement of the requirement than the MPEP, stating, at 1458:

However, the only evidence of record concerning commercial success comprises a statement by the inventor in the § 1.131 affidavit that more than 5,000 lures “constructed according to the disclosure and claims of my patent application” have been sold. The affidavit statement does not reflect the time period during which the lures were sold or the **average number of product sales per unit of time** which would normally be **expected in the market place** under consideration. Accordingly, we cannot determine whether appellant's lure, in fact, has been commercially successful. [emphasis added]

Thus, alternative (b) would be an option for one to provide commercial success evidence beyond mere gross sales figures if he did not have available the overall industry-wide sales from which market share information would necessarily be derived. However, if

he had available (as Applicants have here) reasonably accurate estimates of actual sales in the marketplace, then the expected sales in the marketplace is rendered moot.

In the present case, Applicants do have a good indication of overall actual market sales, and are thus able to sufficiently demonstrate an increasing market share based thereon, as provided under alternative (a)—this demonstration under alternative (a) is sufficient to adequately define the sales figures that demonstrate commercial success by an increasing market share. The declaration shows not only an increase in market sales between the years of 2003–2006, but also a percentage increase in market sales (as required for a proper showing), this despite an overall decline of sales in the marketplace.

In the alternative, Applicants argue that the evidence of actual sales in the marketplace serve as an adequate proxy as to what expected sales in the marketplace would be (in proportion to Applicants’ previous market share) and therefore do constitute the type of evidence the Examiner indicates is lacking in the affidavit. The Examiner has indicated the evidence provides no data to evaluate the increase in market share, when in fact the submitted evidence shows precisely that. Thus, the Examiner is in error in asserting that the declaration and its supporting exhibits does not provide evidence of non-obviousness in accordance with the criterion established in *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

With regard to the motivation to combine the prior art references, the Examiner has suggested that one of ordinary skill in the art would simply combine one metallic decorative nameplate (Pazar) with another transparent substrate with graphics (Takemoto). However, the Examiner has misconstrued the motivation to combined the references. MPEP §2143.01 (VI), and cited case law, state that a proposed modification cannot change the principle of operation of a reference.

In Pazar, the metal nameplate is used for identification purposes, and is intended to be made in a very durable manner. Although Pazar is referring to the aspects of the invention in general, it states at [0009], “This information is provided by archival quality materials that resist wear by the elements and are reliably and easily accessed a century or more after burial without opening the vault.” Thus, the principle of operation in Pazar is a very durable and very easily readable element to permit ease of identification after being buried a century or more. Furthermore, Applicants argue in addition that a metallic name plate in and of itself,

and certainly that disclosed in Figure 23 of Pazar, would not be considered by one of ordinary skill in the art as “decorative”.

The aims of Pazar are at odds with using a decorative plastic, as provided by Takemoto. First, plastic materials would not provide the kind of durability that is central to the principle of operation of the nameplate in Pazar. One seeking to establish durability for identification by future generations would not consider plastic as a solution of durability in view of other significantly more durable materials, such as metal. Secondly to the extent that readability is important, one would further not consider the use of a plastic as being superior in readability to an identification provided on an opaque plate of metal. One would be changing the principle of operation of Pazar (durability, readability) to incorporate the teaching of Takemoto in order to arrive at the present invention. Thus, one of skill in the art would not find a motivation, either within or external to the references, to combine the teaching of Takemoto with that of Pazar to arrive at the present invention.

For all the reasons given above and previously argued during prosecution of the application, Applicants respectfully submit that all claims patentably distinguish over the applied art of record, and it is respectfully requested that the rejections be withdrawn and all claims be allowed.

Respectfully submitted,

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